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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082			EXAMINER SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/854,648	DONNAN, AMY J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dmitry Suhol	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the structural features encompassed by the phrase "tear drop-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase "sun-shaped" can't be determined.

Regarding claim 8, the structural features encompassed by the phrase "fire-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 9, the structural features encompassed by the phrase "ghost-shaped" can't be determined, rendering the claim indefinite.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claim 1 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). While the preamble of claim 13 characterizes the invention as a "method for exploring emotional experience...", a careful reading of the specification reveals that the applicant's invention can best be described as a kit which having articles which in turn create an environment conducive to the exploration of an emotional experience.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that any exploration of an emotional experience will be predictably enabled by the steps set forth. There is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard. Actual exploration of an emotional

experience, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a “tangible” result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). In other words even if a user is able to explore an emotional experience, such a result is merely an abstraction lacking in substance, it is only thoughts or emotions without any physical outcome or manipulation of any physical substance and therefore do not represent a use having any real world value. The method does not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Claims 13-16 and 18 do not produce a useful, concrete, tangible result. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 13-16 and 18 do not define statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by "What a Character" seven dwarves figurines, hereafter referred to as the "seven dwarves". Seven dwarves discloses a plurality of figurines each one with a unique color pattern having a facial expression comprising a mouth and eyes distinctive of a particular emotion and a unique shape (see picture). The container as claimed is pointed to by "boxed weight" where the box is considered to be the container.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al. Van Hoose discloses an interactive toy containing most of the elements of the claims including, providing a plurality of playpieces (fig. 3) as required by claims 1, 13 and 19, each playpiece symbolic of particular emotion (col. 2, lines 35-47) as required by claims 1, 13 and 19, each playpiece comprising a unique shape with respect to the other playpieces (elements 29, 31, 33, 35, 37 and 39) as required by claims 1, 13 and 19, providing a container comprising a storage chamber as required by claims 1, 13 and 19 (element 23 and 45), a first playpiece generally symbolic of love (35) as required by claim 4, a second playpiece generally symbolic of sadness as required by claim 4 (33), a third

playpiece generally symbolic of happiness (31) as required by claim 4, a fourth playpiece generally symbolic of fear (29) as required by claim 4, one or more playpieces comprising one or more panels enclosing a stuffing material (col. 5, lines 18-21 and fig. 3, element 35), a container being heart shaped and a plush pillow bag as required by claims 11 and 12 (elements 23 and 45). Van Hoose further discloses interacting with a toy as required by claims 13-15 (col. 3, lines 6+). Regarding the shapes required by claims 6-9, it is considered that the shapes of the play-pieces, 29, 31, 33, 35, 37 and 39, read on all the shapes required (as best understood). Furthermore, the specific shapes encompassed by claims 6-9 are an obvious design choice in that the applicant discloses no critical need or advantage for them.

Although Van Hoose discloses most of the elements of the claims, as stated above, including each playpiece having a color (col. 2, lines 36-47) the reference fails to teach each playpiece comprising a unique color as required by claims 1 and 13, each playpiece comprising a unique facial expression comprising eyes and mouth as required by claims 1 and 13, a separate playpiece generally symbolic of anger as required by claim 4, and naming an emotion corresponding to a playpiece as required by claim 16. However, Shaver discloses an interactive toy like that of Van Hoose, which teaches the use of a unique color for a plurality of playpieces generally symbolic of a particular emotion (col. 4, lines 58-59 and figs. 10a-10g) as well as a unique facial expression for demonstrating a particular emotion (col. 4, lines 43-46 and figs. 9a-9j). Shaver further teaches that it is know to have user name the emotion corresponding to a playpiece, as required by claim 16, in col. 5, lines 28-37. Therefore it would have been obvious to one

having ordinary skill in the art, at the time of the claimed invention, to incorporate the teachings of Shaver in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other. It would have been further obvious to provide the toy of Van Hoose with a separate playpiece generally symbolic of anger, especially since Van Hoose recognizes anger as an emotion which needs to be displayed (col. 2, line 39) and since representation of anger as an emotion is well known in the art. It would have been further obvious to including the step of naming an emotion corresponding to a playpiece for the purpose of clearly identifying a child's emotions.

Claims 1, 4, 10, 13-15, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '521 in view of Sparks '215 and Shaver et al '778. Solomon discloses an interactive toy for exploring emotional experience containing most of the claimed elements including with reference to claims 1, 13 and 19, providing a plurality of play-pieces (21-26) symbolic of a particular emotion (21a-26a) with a unique facial expression comprising a mouth and eyes (expressions 21a-26a) and a container (10) comprising a storage chamber (41) into which the pieces may be independently stored. Regarding claim 4, lacking any distinguishing limitations, the play-pieces being representative of various emotions including love (24a), sadness (21a), happiness (25a), anger (22a) and fear (26a) are all shown in figure 1. One or more play-pieces comprising one or more panels enclosing a stuffing material, as required by claim 10, are described in col. 2, lines 48-52. The step of interacting with the toy, as required by

claims 13 and 14, is discussed in col. 2, lines 56+. Withdrawing a play-piece from the container, as required by claim 15, is inherent in the device since without such a step the device will not function as intended since the puppets will remain in container 41.

The reference fails to disclose the play-pieces having a unique color and a unique shape respective each other as required by claim 1. However, Sparks teaches the benefits of figures (like those of Solomon) to communicate feelings/emotions through the use of body language (considered different unique shapes, see figure 3 and col. 4, lines 54-58). While Shaver teaches using unique colors associated with a plurality of play-pieces to symbolize emotions/feelings (col. 4, lines 58-59 and figs. 10a-10g). Therefore it would have been obvious to manufacture the figures of Solomon with various and unique shapes/poses and different unique colors for the purpose of further conveying different feelings and emotions, especially since Solomon clearly teaches that the figures of his invention may use color (col. 3, lines 9-10).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al (as stated above) and further in view of Childsworld/Childsplay "Feelings Frogs Game". Van Hoose discloses most of the elements of the claims, as stated above, but for each playpiece comprising textual information indicative of a particular emotion corresponding to a playpiece as required by claims 17-18. However, Childsworld/Childsplay discloses interactive playpieces which teach the use of a unique color and the use of textual information for a plurality of playpieces generally symbolic of a particular emotion (see Childsworld/Childsplay

"Feelings Frogs Game", page 22). Therefore it would have been obvious to incorporate the teachings of Childsworld/Childsplay in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon '521, Sparks '215 and Shaver et al '778, as stated above, and further in view of Childsworld/Childsplay "Feelings Frogs Game". Solomon discloses most of the elements of the claims, as stated above, but for each play-piece comprising textual information indicative of a particular emotion corresponding to a play-piece as required by claims 17-18. However, Childsworld/Childsplay discloses interactive play-pieces which teach the use of a unique color and the use of textual information for a plurality of playpieces generally symbolic of a particular emotion (see Childsworld/Childsplay "Feelings Frogs Game", page 22). Therefore it would have been obvious to incorporate the teachings of Childsworld/Childsplay in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing play-pieces which are distinctive in appearance from each other.

### ***Response to Arguments***

Applicant's arguments filed 12/27/2005 have been fully considered but they are not persuasive. Applicants first argue that the "What a Character", hereafter referred to a "Seven Dwarves", does not anticipate the claims since the reference is not "generally

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symbolic of an emotion" since some of the dwarves are named "sleepy" and "sneezy", does not have a "unique visually discernible facial expression with respect to the other playpieces" since some of the dwarf characters do not have an unambiguous facial expression and are not "playpieces" since they are delicate, made of chalk and are not for the purposes of playing. In response the examiner points out that the facial expressions as shown by the dwarves are unique with respect to each other since their mouth, eyes, brow, cheek and chin facial features are not identical. Furthermore, the names attributed to the dwarfs (i.e. sleepy and sneezy) are not material to the claims since it is the position of the examiner that the facial expression of sneezy is clearly symbolic of anticipation (as in anticipation of a sneeze), while the facial expression of sleepy is symbolic of sadness (as in being sleepy or tired all of the time is indicative of depression/sadness). The figurines are playpieces in as much as they are representations of characters of a story with which users may play with. The materials of construction do not in any way teach away from the reference as being capable of being played with.

Applicants further argue that Solomon and Sparks are non-analogous and therefore their combination is improper. In response the examiner points out that the necessary nexus between the two references is that both are clearly directed to solving the problem of communicating feelings/emotions (see abstract of Solomon and col. 4, lines 54-58 of Sparks and Sparks clearly teaches an improvement over the device of Solomon in that Sparks identifies the benefit of communicating feelings in representations of people through the use of body language. Therefore one of ordinary

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skill in the art would have certainly looked to the teachings of both Solomon and Sparks at the time of applicants claimed invention.

Applicants further appear to argue that Solomon teaches away from modifying his playpiece shape of since he states that each playpiece should be the same character. In response, the examiner points out that Solomon envisions his playpiece to be the same character since the playpiece is gender and culture neutral, however Sparks is not relied upon to teach genders or various cultural identifications but is only relied upon to teach the use of body language.

Applicants further argue that Solomon lacks the teaching of a container. In response the examiner disagrees and points out that container 41 fully encompasses the claimed limitations of applicants container.

Applicants further appear to argue that Solomon lacks the teaching of a unique shape symbolic of the emotion indicated by the facial expression. In response the examiner points out that Solomon already clearly teaches unique expressions indicative of a particular emotion, while Sparks is relied upon to teach that it is known to provide playpieces, like the ones of Solomon, with various body language shapes to further communicate a particular emotion/feeling (col. 4, lines 54-58). Therefore it is the position of the examiner that incorporating the body language of Sparks with the playpieces of Solomon would have been obvious for the purpose of further communicating the feelings displayed by the playpieces to the user, where it is considered that the body language taught by Sparks when combined with the unique

emotions taught by Solomon would result in the playpieces of Solomon with unique shapes symbolic of unique emotions indicated by unique facial expressions.

Applicants further argue that the idea of "sameness" teaches away from the use of various colors are taught by Shaver. In response the examiner points out that the "sameness" idea of Solomon is directed to gender and culturally neutral playpieces and that Solomon clearly states that color may be used with his playpieces (col. 3, lines 9-10).

Applicants further argue that Shaver teaches away from the use of more than one unique feature in a single playpiece. In response the examiner points out that it is the Solomon reference which is being modified and not the Shaver reference and since Solomon envisions the use of color (see above) the addition of unique colors of Shaver symbolic of unique emotions in no way destroys the Solomon reference.

With regard to the Childsworld/Childsplay reference, the examiner relies upon the reference to teach that it is known to provide playpieces indicative of an emotion with textual information indicative of the emotion displayed by the playpiece and not facial expressions of playpiece shapes (already taught by Solomon, Sparks, Shaver and Van Hoose).

With respect to the rejections under 35 USC 112, second paragraph, applicants argue that the shapes as claimed fully meet the requirements of USC 112, 2<sup>nd</sup> paragraph. As support applicants list a variety of patents which use shape descriptive terminology, such as "teddy bear", "tear-drop shape", "heart shape" among others. In response the examiner points out that none of the patents listed by the

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applicants appear to use terms such as, "sun-shaped", "fire shaped" or "ghost shape" in the claim language. The examiner further points out that USC 112, 2<sup>nd</sup> paragraph stipulates that:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In this case the use of language such as "tear drop-shaped", "sun-shaped", "fire-shaped", "ghost-shaped" is not a distinct shape which has clear metes and bounds. For example, a tear drop shape could be a variety of shapes such as a circle, oval, or blob with no clear defined boundaries, a sun shape can be a variety of shapes such as a circle, an oval, a half circle among others and as to a fire shape the examiner can't even begin to describe the variety of shapes that are encompassed by such a term.

Applicants further point to a definition for a tear-drop shape, however it should be pointed out that Merriam-Webster's Collegiate Dictionary, Tenth Edition defines a tear drop shape as "something shaped like a dropping tear" with no other stipulations and keeping in mind the variety of shapes that are encompassed by a drop of falling liquid, as stated above, the term is indefinite. Furthermore the examiner is puzzled as to why the applicants simply do not use clear and concise terms to define their shapes and not ambiguous and unclear language as is currently used in order to clearly define their playpiece shapes. Additionally, applicants point to their specification for exemplary embodiments of particular shapes, however the examiner points out that although the claims are read in light of the specification it would be highly inappropriate for the examiner to read limitations from the specification into the claims. Therefore, the shapes

claimed by the applicants DO NOT have a specific and particular structure which fits the definition of 35 USC 112 and therefore the rejection is maintained

Applicants further argue that since patents drawn to psychological methods have been issued that have not achieved a specific tangible result then therefore their method claims are statutory under 35 USC 101. In response the examiner points out that a recently developed test for the determination of patent eligible matter is whether the invention produces a useful, concrete and tangible result. See e.g., State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have a practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance. In this case the claims (e.g. claim 1) merely set forth steps which provide a toy and associated play pieces and interacting with the toy in order to explore an emotional experience. In which case, the claimed invention does not produce a “concrete” result in the sense that it cannot be reasonably assured that any exploration of an emotional experience will be predictably enabled by the steps set forth (i.e. mere interaction with the toy by a user, such as a child, has a good chance of simply resulting in play without any exploration of any emotional experience). Furthermore, the steps fail to produce a “tangible” result in any way. In other words, even if a user is able to explore an emotional experience, such a result is merely an abstraction lacking in substance, it is only thoughts or emotions without any physical outcome or manipulation of any physical substance and therefore do not represent a use having any real world value.

Applicants further argue the combination of Van Hoose and Shaver is improper since Shaver teaches away from combining multiple features into one playpiece. In response the examiner points out that it is the Van Hoose reference which is being modified and not the Shaver reference and Van House in no way sets any type of condition that his playpieces can not have multiple distinguishing features and therefore the addition of the Shaver teachings (facial expressions and unique colors) would in no way destroy the Van Hoose reference.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol  
Primary Examiner  
Art Unit 3725

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